



PTO/SB/21 (04-04)

**TRANSMITTAL  
FORM**

(to be used for all correspondence after initial filing)

Application Number	09/997,311
Filing Date	November 27, 2001
First Named Inventor	Shay, James R.
Art Unit	2171
Examiner Name	Santos, Patrick J.D.
Attorney Docket Number	021737-001410US

Total Number of Pages in This Submission

**ENCLOSURES (Check all that apply)**

- |  |   |   |
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| <input type="checkbox"/> Fee Transmittal Form<br><input type="checkbox"/> Fee Attached<br><input type="checkbox"/> Amendment/Reply<br><input type="checkbox"/> After Final<br><input type="checkbox"/> Affidavits/declaration(s)<br><input type="checkbox"/> Extension of Time Request<br><input type="checkbox"/> Express Abandonment Request<br><input checked="" type="checkbox"/> Information Disclosure Statement<br><input type="checkbox"/> Certified Copy of Priority Document(s)<br><input type="checkbox"/> Response to Missing Parts/Incomplete Application<br><input type="checkbox"/> Response to Missing Parts under 37 CFR 1.52 or 1.53 | <input type="checkbox"/> Drawing(s)<br><input type="checkbox"/> Licensing-related Papers<br><input type="checkbox"/> Petition<br><input type="checkbox"/> Petition to Convert to a Provisional Application<br><input type="checkbox"/> Power of Attorney, Revocation<br>Change of Correspondence Address<br><input type="checkbox"/> Terminal Disclaimer<br><input type="checkbox"/> Request for Refund<br><input type="checkbox"/> CD, Number of CD(s) _____ | <input type="checkbox"/> After Allowance Communication to Technology Center (TC)<br><input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences<br><input type="checkbox"/> Appeal Communication to TC (Appeal Notice, Brief, Reply Brief)<br><input type="checkbox"/> Proprietary Information<br><input type="checkbox"/> Status Letter<br><input checked="" type="checkbox"/> Other Enclosure(s) (please identify below):<br>Return Postcard, copies of one hundred and five (105) cited references |
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Remarks	The Commissioner is authorized to charge any additional fees to Deposit Account 20-1430.
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**SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT**

Firm or Individual name	Townsend and Townsend and Crew LLP Chad E. King	Reg. No. 44,187
Signature		
Date	8/18/04	

**CERTIFICATE OF TRANSMISSION/MAILING**

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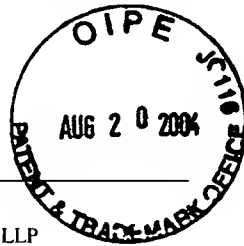
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SPR 2171  
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On August 18, 2004

TOWNSEND and TOWNSEND and CREW LLP

By: Nicole Wartell  
Nicole Wartell

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re application of:

JAMES R. SHAY et al.

Application No.: 09/997,311

Filed: November 27, 2001

For: COMPUTER IMPLEMENTED  
METHOD FOR CONTROLLING  
DOCUMENT EDITS

Examiner: Santos, Patrick J.D.

Art Unit: 2171

SUPPLEMENTAL INFORMATION  
DISCLOSURE STATEMENT UNDER 37  
CFR §1.97 and §1.98

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

The references cited on attached form PTO/SB/08A and PTO/SB/08B are being called to the attention of the Examiner. Copies of the references are enclosed. It is respectfully requested that the cited references be expressly considered during the prosecution of this application, and the references be made of record therein and appear among the "references cited" on any patent to issue therefrom.

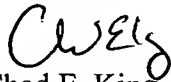
As provided for by 37 CFR 1.97(g) and (h), no inference should be made that the information and references cited are prior art merely because they are in this statement and no

representation is being made that a search has been conducted or that this statement encompasses all the possible relevant information.

Applicant believes that no fee is required for submission of this statement.

However, if a fee is required, the Commissioner is authorized to deduct such fee from the undersigned's Deposit Account No. 20-1430. Please deduct any additional fees from, or credit any overpayment to, the above-noted Deposit Account.

Respectfully submitted,

  
Chad E. King  
Reg. No. 44,187

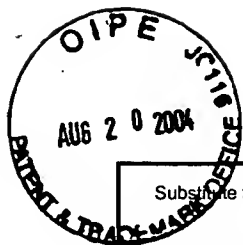
TOWNSEND and TOWNSEND and CREW LLP  
Two Embarcadero Center, Eighth Floor  
San Francisco, California 94111-3834  
Tel: 303-571-4000  
Fax: 303-571-4321  
CEK:nmb  
60276658 v1



Substitute for form 1449A/PTO <b>INFORMATION DISCLOSURE STATEMENT BY APPLICANT</b> (use as many sheets as necessary)			<b>Complete if Known</b>	
			Application Number	09/997,311
			Filing Date	November 27, 2001
			First Named Inventor	Shay, James R.
			Art Unit	2171
Examiner Name	Santos, Patrick J.D.			
Sheet 1 of 5	Attorney Docket Number 021737-001410US			

U.S. PATENT DOCUMENTS+					
Examiner Initials*	Cite No. <sup>1</sup>	Document Number	Publication Date MM-DD-YYYY	Name of Patentee or Applicant of Cited Document	Pages, Columns, Lines, Where Relevant Passages or Relevant Figures Appear
		Number Kind Code <sup>2</sup> (if known)			
	A1	US-5,247,661	09-21-1993	Hager et al.	
	A2	US-5,276,869	01-04-1994	Forrest et al.	
	A3	US-5,317,683	05-31-1994	Hager et al.	
	A4	US-5,377,355	12-27-1994	Hager et al.	
	A5	US-5,418,908	05-23-1995	Keller et al.	
	A6	US-5,446,880	08-29-1995	Balgeman et al.	
	A7	US-5,485,605	01-16-1996	Johnson et al.	
	A8	US-5,553,289	09-03-1996	Johnson et al.	
	A9	US-5,619,555	04-08-1997	Fenton et al.	
	A10	US-5,628,004	05-06-1997	Gormley et al.	
	A11	US-5,649,117	07-15-1997	Landry	
	A12	US-5,659,676	08-19-1997	Redpath	
	A13	US-5,717,863	02-10-1998	Adamson et al.	
	A14	US-5,745,901	04-28-1998	Entner et al.	
	A15	US-5,758,126	05-26-1998	Daniels et al.	
	A16	US-5,764,898	06-19-1998	Tsuji et al.	
	A17	US-5,774,866	06-30-1998	Horwitz et al.	
	A18	US-5,781,901	07-14-1998	Kuzma	
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	A20	US-5,797,001	08-18-1998	Augenbraun et al.	
	A21	US-5,802,518	09-01-1998	Karaev et al.	
	A22	US-5,806,057	09-08-1998	Gormley et al.	
	A23	US-5,809,242	09-15-1998	Shaw et al.	
	A24	US-5,812,795	09-22-1998	Horovitz et al.	
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	A26	US-5,832,211	11-03-1998	Blakley, III et al.	
	A27	US-5,832,220	11-03-1998	Johnson et al.	
	A28	US-5,857,181	01-05-1999	Augenbraun et al.	
	A29	US-5,862,323	01-19-1999	Blakely, III et al.	
	A30	US-5,864,871	01-26-1999	Kitain et al.	
	A31	US-5,874,953	02-23-1999	Webster et al.	
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	A33	US-5,903,881	05-11-1999	Schrader et al.	
	A34	US-5,907,835	05-25-1999	Yokomizo et al.	
	A35	US-5,950,174	09-07-1999	Brendzel	
	A36	US-5,956,034	09-21-1999	Sachs et al.	
	A37	US-5,982,898	11-09-1999	Hsu et al.	
	A38	US-5,987,464	11-16-1999	Schneider	
	A39	US-6,006,242	12-21-1999	Poole et al.	
	A40	US-6,012,044	01-04-2000	Maggioncalda et al.	
	A41	US-6,014,135	01-11-2000	Fernandes	
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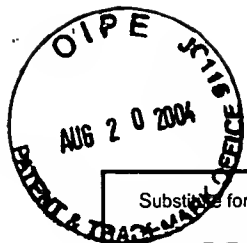
Substitute for form 1449A/PTO <b>INFORMATION DISCLOSURE STATEMENT BY APPLICANT</b> (use as many sheets as necessary)			<b>Complete if Known</b>		
Sheet	2	of	5	Application Number	09/997,311
				Filing Date	November 27, 2001
				First Named Inventor	Shay, James R.
				Art Unit	2171
				Examiner Name	Santos, Patrick J.D.
				Attorney Docket Number	021737-001410US

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Examiner Initials*	Cite No. <sup>1</sup>	Document Number	Publication Date MM-DD-YYYY	Name of Patentee or Applicant of Cited Document	Pages, Columns, Lines, Where Relevant Passages or Relevant Figures Appear
		Number Kind Code <sup>2</sup> (if known)			
	A42	US-6,014,502	01-11-2000	Moraes	
	A43	US-6,032,124	02-29-2000	Saito et al.	
	A44	US-6,040,920	03-21-2000	Ichinki	
	A45	US-6,043,816	03-28-2000	Williams et al.	
	A46	US-6,047,315	04-04-2000	Tsuji et al.	
	A47	US-6,064,976	05-16-2000	Tolopka	
	A48	US-6,141,007	10-31-2000	Lebling et al.	
	A49	US-6,298,327 B1	10-02-2001	Hunter et al.	
	A50	US-2001/0037460 A1	11-01-2001	Porcani	
	A51	US-2001/0049707 A1	12-06-2001	Tran	
	A52	US-6,363,361 B1	03-26-2002	Lundberg	
	A53	US-2002/0042784 A1	04-11-2002	Kerven et al.	
	A54	US-2002/0059076 A1	05-16-2002	Grainger et al.	
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	A57	US-2002/0065677 A1	05-30-2002	Grainger et al.	
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	A59	US-2002/0111953 A1	08-15-2002	Snyder	
	A60	US-6,442,549 B1	08-27-2002	Schneider	
	A61	US-6,549,894 B1	04-15-2003	Simpson et al.	
	A62				

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Examiner Initials*	Cite No. <sup>1</sup>	Foreign Patent Document			Publication Date MM-DD-YYYY	Name of Patentee or Applicant of Cited Document	Pages, Columns, Lines, Where Relevant Passages or Relevant Figures Appear	T <sup>6</sup>
		Country Code <sup>3</sup>	Number <sup>4</sup>	Kind Code <sup>5</sup> (if known)				
	B1	PCT	WO 98/26343	A2	06-18-1998			<input type="checkbox"/>
	B2	PCT	WO 02/05150	A2	01-17-2002			<input type="checkbox"/>
	B3	PCT	WO 01/24035	A2	04-05-2001			<input type="checkbox"/>
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Sheet	3	of	5	Attorney Docket Number	021737-001410US

NON PATENT LITERATURE DOCUMENTS			
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	C1	Computer Patent Annuities Limited Partnership, "CPA Renewal Services" Retrieved from the Internet <http://www.cpajersey.com/cpajersey/patent1.html on 09/04/2002	
	C2	Computer Patent Annuities, "CPA Direct" retrieved on 2001-09-11]. Retrieved from the Internet: <URL: http://www.cpajersey.com/cpajersey/welcome.htm> 18 pages total.	
	C3	Computer Patent Annuities, "Memotech Interface Systeme: IP Management Software Services From CPA" [retrieved on 2001-09-11]. Retrieved from the Internet: <URL: http://www.cpajersey.com/cpajersey/mis1.htm> 1 page total.	
	C4	Computer Patent Annuities, "Memotech IP Suite Features" [retrieved on 2001-09-11]. Retrieved from the Internet: <URL: http://www.cpajersey.com/cpajersey/mis2.htm> 3 pages total.	
	C5	Computer Patent Annuities, "Technical Specifications" [retrieved on 2001-09-11]. Retrieved from the Internet: <URL: http://www.cpajersey.com/cpajersey/mis3.htm> 2 pages total.	
	C6	Computer Patent Annuities, "Welcome to CPA" [retrieved on 2001-09-11]. Retrieved from the Internet: <URL: http://www.cpajersey.com/cpajersey/maincombo.htm> 1 page total.	
	C7	CPI Computer Packages Inc. [retrieved on 2001-09-11]. Retrieved from the Internet: <URL: http://www.computerpackages.com/> 1 page total.	
	C8	CPI Computer Packages Inc., "Patent System" [retrieved on 2001-09-11]. Retrieved from the Internet: <URL: http://www.computerpackages.com/patent.asp> 2 pages total.	
	C9	CPI Computer Packages Inc., "CPI News" Spring 2001 [retrieved on 2001-09-11]. Retrieved from the Internet: <URL: http://www.computerpackages.com/> 4 pages total.	
	C10	CPI Computer Packages Inc., "Patent Annuity Payment Service" [retrieved on 2001-09-11]. Retrieved from the Internet: <URL: http://www.computerpackages.com/annuity.asp> 1 page total.	
	C11	CPI Computer Packages Inc., "Products and Services" [retrieved on 2001-09-11]. Retrieved from the Internet: <URL: http://www.computerpackages.com/products.asp> 1 page total.	
	C12	CPI Computer Packages Inc., "Trademark System" [retrieved on 2001-09-11]. Retrieved from the Internet: <URL: http://www.computerpackages.com/trademar.asp> 2 pages total.	
	C13	CPI Computer Packages Inc., "What's New" [retrieved on 2001-09-11]. Retrieved from the Internet: <URL: http://www.computerpackages.com/whatsnew.asp> 2 pages total.	
	C14	CPI Computer Packages Inc., "CPI News" Fall 2001, 4 pages total.	
	C15	Intuit "Electronic Filing software with ProSeries/1040 and individual states" [retrieved on 2001-07-11]. Retrieved from the Internet: <URL: http://www.proseries.com/efiling/index.shtml> 2 pages total.	
	C16	Intuit "TurboTax Premier for Tax Year 2001" [retrieved on 2001-07-11]. Retrieved from the Internet: <URL: http://www.shopintuit.com/qstore/ProdInfo.asp?BaseCode=TTPRW2001&> 6 pages total.	

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Sheet	4	of	5	Attorney Docket Number	021737-001410US

NON PATENT LITERATURE DOCUMENTS			
Examiner Initials *	Cite No. <sup>1</sup>	Include name of the author (in CAPITAL LETTERS), title of the article (when appropriate), title of the item (book, magazine, journal, serial, symposium, catalog, etc.), date, page(s), volume-issue number(s), publisher, city and/or country where published.	T <sup>2</sup>
	C17	Intuit Press Release: "E-Filing Completely Paperless With Quicken TurboTax Now Even Easier To Get A Tax Refund Fast" [retrieved on 2001-07-11]. Retrieved from the Internet: <URL: <a href="http://www.intuit.com/company/press_releases/2001/01-12c.html">http://www.intuit.com/company/press_releases/2001/01-12c.html</a> > 2 pages total.	
	C18	IPSearchEngine.com [retrieved on 2001-10-11]. Retrieved from the Internet: <URL: <a href="http://www.ipsearchengine.com/index.asp?">http://www.ipsearchengine.com/index.asp?</a> > 17 pages total.	
	C19	IRS "Electronic Services Approved IRS e-file for Business Providers" [retrieved on 2001-07-11]. Retrieved from the Internet: <URL: <a href="http://www.irs.gov/plain/elect_svs/efile-abp.html">http://www.irs.gov/plain/elect_svs/efile-abp.html</a> > 3 pages total.	
	C20	IRS "Electronic Services IRS e-file for Businesses" [retrieved on 2001-07-11]. Retrieved from the Internet: <URL: <a href="http://www.irs.gov/plain/elect_svs/efile-bus.html">http://www.irs.gov/plain/elect_svs/efile-bus.html</a> > 2 pages total.	
	C21	IRS "Electronic Services IRS e-file for Individual Taxpayers" [retrieved on 2001-07-11]. Retrieved from the Internet: <URL: <a href="http://www.irs.gov/plain/elect_svs/efile-ind.html">http://www.irs.gov/plain/elect_svs/efile-ind.html</a> > 2 pages total.	
	C22	IRS "Electronic Services" [retrieved on 2001-07-11]. Retrieved from the Internet: <URL: <a href="http://www.irs.gov/plain/elect_svs/index.html">http://www.irs.gov/plain/elect_svs/index.html</a> > 2 pages total.	
	C23	"Legal Automation News" Issue 19.1, Executive Data Systems, Inc., 2100 Ponce de Leon Blvd., Suite 1200, Coral Gables, FL 33134, pp. 1-4, 1997	
	C24	"Legal Automation Newsletter" Vol. 20, Issue 1, Executive Data Systems, Inc., 2100 Ponce de Leon Blvd., Suite 1200, Coral Gables, FL 33134, pp. 1-6, 1999.	
	C25	LegalStar® Product Solicitation/Brochure entitled "IP Legal Dock Pro Document Management Software for IP Law" ©1999, LegalStar®, P.O. Box 415, Williamsville, NY 14231-0415, 5 pages total	
	C26	Patent Information Services of Computer Packages Inc. [retrieved on 2001-09-11]. Retrieved from the Internet: <URL: <a href="http://www.patentinfoserv.com/">http://www.patentinfoserv.com/</a> > 1 page total.	
	C27	PatentWizard Inc. "About PatentWizard" [retrieved on 2001-24-10]. Retrieved from the Internet: <URL: <a href="http://www.patentwizard.com/htmls/about.htm">http://www.patentwizard.com/htmls/about.htm</a> > 6 pages total.	
	C28	PatentWizard, Inc. [retrieved on 2001-24-10]. Retrieved from the Internet: <URL: <a href="http://www.patentwizard.com/">http://www.patentwizard.com/</a> > 3 pages total.	
	C29	PCT Easy "FAQ" [retrieved on 2001-05-11]. Retrieved from the Internet: <URL: <a href="http://pcteasy.wipo.int/en/help/faq.htm">http://pcteasy.wipo.int/en/help/faq.htm</a> > 7 pages total.	
	C30	PerfectLaw Software "About the Company" [retrieved on 2001-05-11]. Retrieved from the Internet: <URL: <a href="http://www.perfectlaw.com/about.the.htm">http://www.perfectlaw.com/about.the.htm</a> > 2 pages total.	
	C31	PerfectLaw Software "Back Office Software" [retrieved on 2001-05-11]. Retrieved from the Internet: <URL: <a href="http://www.perfectlaw.com/Backoff.htm">http://www.perfectlaw.com/Backoff.htm</a> > 1 pages total.	
	C32	PerfectLaw Software "Case & Matter Management Custom Information Fields" [retrieved on 2001-05-11]. Retrieved from the Internet: <URL: <a href="http://www.perfectlaw.com/customtabs.htm">http://www.perfectlaw.com/customtabs.htm</a> > 1 page total.	

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	C33	PerfectLaw Software "Case & Matter Management Docket Scheduling" [retrieved on 2001-05-11]. Retrieved from the Internet: <URL: <a href="http://www.perfectlaw.com/docketsch">http://www.perfectlaw.com/docketsch</a> > 2 pages total.	
	C34	PerfectLaw Software "Case & Matter Management Documents Processing" [retrieved on 2001-05-11]. Retrieved from the Internet: <URL: <a href="http://www.perfectlaw.com/docprocessing.htm">http://www.perfectlaw.com/docprocessing.htm</a> > 1 page total.	
	C35	PerfectLaw Software "DocPro" [retrieved on 2001-05-11]. Retrieved from the Internet: <URL: <a href="http://www.perfectlaw.com/docpro.htm">http://www.perfectlaw.com/docpro.htm</a> > 8 pages total.	
	C36	PerfectLaw Software "Front Office Software" [retrieved on 2001-05-11]. Retrieved from the Internet: <URL: <a href="http://www.perfectlaw.com/frontoff.htm">http://www.perfectlaw.com/frontoff.htm</a> > 2 pages total.	
	C37	PerfectLaw Software "Scheduling and Time Management Printing daily/weekly/monthly calendars" [retrieved on 2001-05-11]. Retrieved from the Internet: <URL: <a href="http://www.perfectlaw.com/printing.htm">http://www.perfectlaw.com/printing.htm</a> > 2 pages total.	
	C38	PerfectLaw Software "Scheduling and Time Management Reminders and Alarms" [retrieved on 2001-05-11]. Retrieved from the Internet: <URL: <a href="http://www.perfectlaw.com/reminders.htm">http://www.perfectlaw.com/reminders.htm</a> > 3 pages total.	
	C39	United States Patent and Trademark Office, U.S. Patent Application Specification Authoring Guide for WordPerfect XML Template, Washington, DC, December 14, 1999, pp. 1-65.	
	C40	United States Patent and Trademark Office, EFS Electronic Filing System "Submission Manual ePAVE" Retrieved from the Internet: <URL: <a href="http://www.uspto.gov/">http://www.uspto.gov/</a> > on 2001-09-11, 157 pages total.	
	C41		

Examiner Signature		Date Considered	
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<sup>1</sup> Applicant's unique citation designation number (optional). <sup>2</sup> Applicant is to place a check mark here if English language Translation is attached.